REMARKS

Claims 1 – 8 are in the application. Claims 1 and 5 have been rejected and claims 2 – 4 and 6 – 8 have been indicated to be directed to allowable subject matter.

Claim 1, the only independent claim, has been amended. Specifically, in line 11, the expressions "threaded end portion", both occurrences, has been changed to –threaded portion--. In line 13, "include" has been changed to –includes--.

It is submitted that claims 1 – 8 are all patentable over Miller 3,465,488; Osterle et al. 6,428,258; DeFrancesco et al. 5,685,121 and Hauser 3,492,906.

Claim 1 specifies that the upper end portion of the stud is sized to fit within the upper channel space. Claim 1 further specifies that the upper end portion of the stud includes "spaced-apart side walls that are contiguous with the side walls of the upper channel member when the upper end portion of the stud is within the upper channel space." This arrangement is not shown by Miller 3,465,488. As clearly shown by Fig. 3 of Miller 3,465,488, wallboard panels 4 are connected to the studs 2 in such a manner that the wallboard panels 4 extend all the way up to the upper ends of the studs 2. The channel member 10 is referred to as a "cap." It is installed on the upper portion of the wall with its top on the tops of the studs and panels and its side walls 11 contiguous the outer surfaces of the panels 4. The studs 2 are spaced from the cap side walls 11 a distance equal to the thickness of panels 4. Miller discloses that nails 15 are used for securing the side walls 11 of the "cap" 10 to the panels 4. There is no disclosure of connecting the cap side walls 11 to the studs 2. There is no disclosure of providing the studs 2 with vertical slots and using a screw fastener with the side walls 11 and studs 2.

Claim 1 specifies that the screw fastener is connected to the sidewall of the

upper channel member with a shank extending through the slot in the stud. This feature is not disclosed by any of the references. Claim 1 specifies that when the screw is connected to the sidewall of the upper channel, an unthreaded portion of the shank of the screw fastener is in the slot and said slot is wider than the unthreaded portion of the shank of the screw fastener. These features are not disclosed by any of the referenced patents. Claim 1 specifies that the threaded portion of the shank of the screw fastener includes "an end thread spaced close to the upper end portion of the stud, said end thread being wider than the slot so that it will contact the stud on the sides of the slot and prevent the screw from being pulled out of the socket." This feature is shown by Fig. 6 of the drawing. It is not shown by the prior art.

DeFrancesco 5,685,121 discloses a two-part stud having a first part that is telescopically received in a second part. The first part includes a slot 34. However, claim 1 specifies a slot in the upper end portion of the stud "contiguous with the sidewalls of the upper channel member when the upper end portion of the stud is within the upper channel space." This arrangement is not disclosed by DeFrancesco 5,685,121. DeFrancesco 5,685,121 does not show what kind of fasteners are used for securing the wallboard 48 to the stud sections 20. There is very clearly no disclosure of using a screw fastener with threads larger in diameter than the width of the slot and an unthreaded portion having a diameter less than the width of the slot. On page 8 of the description herein, starting on line 12, it is stated:

> If a sideways force is applied against the wall in one direction, the screw heads 54 will be forced against member 16. In the opposite direction, the thread ends 64 will be moved against the portions of stud wells 32 that border the slot 48. In either event, the sideways forces are carried at the screw connections. Accordingly, this construction allows relative movement in the vertical direction, such as might occur during an earthquake or because of settling, while the walls brace at least to some

extent in the sideways direction. Thus, the walls better able to resist wind loads and other types of side loads that it might encounter.

On page 3 of the Office Action, the Examiner states that Osterle's screw is capable of being connected to the sidewall of the upper channel 10 of Miller with its shank extending through the slot and the unthreaded portion of the shank in the slot. Firstly, Miller 3,465,488 does not disclose a stud having a vertical slot. Secondly, Osterle 6,428,258 only discloses a screw 1. It does not disclose any relationship between the diameter of the shank portion 11 and a slot and the diameter of the end thread and the same slot. It does not disclose an axial distance between the head of the screw and the end thread that would cause the end thread to contact the stud on the sides of the slot and prevent the screw from being pulled out of the slot.

In the rejection, the Examiner states that the term "adapted to do" is not positively claiming the structure but merely alleges what the structure can do. In this regard, references made to In re. *Venezia*, 530 F2d 956, 189 USPQ 149 (CCPA 1976) in which the court very clearly stated that the language "each sleeve of said pair adapted to be fitted over the insulating jacket of one of said cables" was a proper limitation. The court stated:

> Rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so structured or dimensioned that it can fitted over the insulating jacket of the cable. A similar situation exists with respect to the "adapted to be affixed" and "adapted to be positioned" limitations in the third and fourth paragraphs of the claim.

The Court of Appeals for the Federal Circuit has followed In re: *Venezia.* See *Pac-Tec, Inc. v. Amerace Corp.*, 903 F2d 796, 14 USPQ 2d 1871 (Fed. Cir. 1990):

> Pac-Tec's primary attack on validity is based on the assertion that *Amerace's* claimed inventions are anticipated by the disclosures in three patents considered by the Patent and Trademark Office Examiner. The assertion rests on Pac-Tec's improper redrafting of the claims by deleting the preamble and all limitations that include "adapted to", "whereby", and "whereby" so that the claims are reduced to mere collections of parts.

> Pac-Tec totally disregards the district court's careful consideration, after a full trial on the § 102(a) and (b) issues, of the claims as wholes. In so doing, the court found that the language excised by Pac-Tec constituted structural limitations, citing as a thirty In re: *Venezia*, 530 F2d 956, 189 USPQ 149 (CCPA 1976). In its brief here, *Amerace* cited seven additional authorities for the proposition that functional language, in cases like the present, cannot be disregarded. Although Pac-Tec cited 48 cases in its main brief and 15 cases in its reply brief, it nowhere even mentions *Venezia* or any of the authorities cited by *Amerace*.

Also in the rejection, the Examiner states that "Hauser discloses an end thread wider than the slot or opening so that it will contact the structural member on the sides of the opening and prevent the screw from being pulled out of the slot." Hauser 3,492,906 does not disclose a slot in a stud. It discloses a fastener with threads at each end. The claimed screw fastener has a non-threaded shank axially between a head and an enlarged diameter thread. This is not what is disclosed by Hauser 3,492,906. There is no disclosure in this patent of using the fastener in the claimed manner and the fastener is very clearly not constructed to permit it to be used in the claimed manner.

Claim 5 depends from claim 1 and adds a lower channel member at the bottom of the wall. The claim specifies that the lower channel member is connected to the stud. The upper end of the stud is connected to the upper channel member by a screw fastener that extends through a vertical slot in the upper end portion of the stud. This permits relative movement in the vertical direction between the upper channel member and the stud. As previously explained, the head of the screw fastener and the enlarge diameter thread resist sideways movement of the stud relative to the upper channel member. In one direction, the movement is stopped by contact of the screw head and the sidewall of the upper channel member. In the opposite direction, the movement is prevented by contact of the end thread and the metal that borders the slot.

It is submitted that claims 1 – 8 are allowable for the reasons discussed above.

Accordingly, early reconsideration and allowance of this application are requested.

Respectfully submitted,

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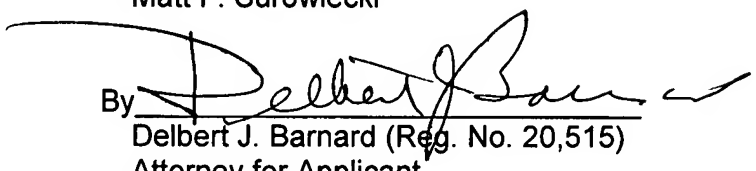
By 

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